

### REMARKS

Applicant has carefully studied the Office Action of September 19, 2005 and offers the following remarks in response thereto.

Before addressing the rejections, Applicant provides a brief summary of the present invention so that the remarks relating to the rejections are considered in the proper context. The present invention is designed to act as an effective proxy for a telephone and multimedia device so that a network would perceive the two elements as a single device. The combined user agent (CUA), however, has a telephony switch between the combined user agent and the telephone (see Figures 1-4, wherein the CUA 14 has switch 24 between the CUA 14 and the telephone 22). Thus, to establish a connection with the telephone, the CUA has to make the connection through the telephony switch.

Claims 1-6, 9-15, 18-24, and 27 were rejected under 35 U.S.C. § 102(e) as being anticipated by Tonnby et al. (hereinafter "Tonnby"). Applicant respectfully traverses. For the Patent Office to prove anticipation, the Patent Office must show where each and every element of the claim is shown in the reference. Furthermore, the elements of the reference must be arranged as claimed. MPEP § 2131.

Applicant initially traverses the Patent Office's statements relating to the "adapted to" language of the claims. Specifically, the Patent Office states:

\*Note: The claim limitations that employ phrases of the type "adapted to"; "capable for" are typical of claim limitations, which may not distinguish over the prior art. The limitations after the "adapted to" or "capable for" performing a function is not a (consider) positive limitation but only requires the ability to so perform.

(Office Action of September 19, 2005, page 2, lines 18-21). This assertion is unsupported by any citation, and is, in fact, a misstatement of the applicable case law. Contrary to the Patent Office's assertion, the Federal Circuit has mandated that "adapted to" language is a positive limitation and must be considered when weighing patentability. *Pac-Tec, Inc. v. Amerace Corp.*, 903 F.2d 796, 801 (Fed. Cir. 1990) (citing *In re Venezia*, 530 F.2d 956 (CCPA 1976)). When the proper weight is afforded the "adapted to" language of the claims, it is readily apparent that Tonnby does not anticipate the claims.

Applicant traverses the rejection because Tonnby does not teach a claim element. Specifically, claim 1 recites the control system adapted to "communicate with a circuit-switched

telephony switch to establish a connection with the telephone **through** the circuit-switched telephony switch . . .” (emphasis added). The Patent Office asserts that the control system is Tonnby’s element 24, the telephone is element 5 of Figure 4 of Tonnby, and that the telephone coupled with the PSTN 2 of Figure 4 shows this element. However, the arrangement of Tonnby’s Figure 4 does not correspond to the claim language. That is, the claim requires that the connection be established through the telephony switch to the telephone. In contrast, element 24 is positioned between the telephone 5 and the PSTN 2 in Figure 4. Thus, it is not possible that the control system can establish a connection to the telephone 5 **through** the PSTN 2. Since the claim clearly recites that the connection must be established **through** the telephony switch to the telephone, and the reference shows that such an arrangement is not possible, Tonnby cannot anticipate claim 1.

Claims 2-6 and 9 depend from claim 1 and are not anticipated at least for the same reasons.

Claim 10 recites essentially the same element, albeit in method form. As such, claim 10 is not anticipated. Claims 11-15 and 18 depend from claim 10 and are not anticipated at least for the same reasons.

Claim 19 recites essentially the same element, albeit in a software format. As such, claim 19 is not anticipated. Claims 20-24 and 27 depend from claim 19 and are not anticipated at least for the same reasons.

Claims 7, 8, 16, 17, 25, and 26 were rejected under 35 U.S.C. § 103 as being unpatentable over Tonnby in view of Schuster et al. (hereinafter “Schuster”). Applicant respectfully traverses. For the Patent Office to combine references in an obviousness rejection, the Patent Office must prove that there is a suggestion to combine the references. To prove that there is a suggestion to combine the references, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Even if the combination is proper, to establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination. MPEP § 2143.03.

Applicant initially traverses the rejection because the Patent Office has not properly supported the motivation to combine the references. In particular, the Patent Office asserts that

the motivation is "to implement the session initiation protocol for setup communication in the network." (Office Action of September 19, 2005, page 5, lines 8-9). This asserted motivation lacks the requisite evidence. Since the motivation lacks the required evidence, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper. Since the rejection is improper, the Patent Office has not established obviousness, and the claims are allowable. Applicant requests withdrawal of the § 103 rejection on this basis.

Applicant further traverses the rejection because the combination does not teach or suggest that the connection is made through the telephony switch to the telephone. As explained above, Tonnyby does not teach or suggest this element. Nothing in Schuster cures the deficiencies of Tonnyby. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the combination does not establish obviousness. Since the combination does not establish obviousness, the claims are allowable. Applicant requests withdrawal of the § 103 rejection on this basis, as well.

Applicant requests reconsideration of the rejections in light of the remarks presented herein. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

<p><b>CERTIFICATE OF TRANSMISSION</b> I HEREBY CERTIFY THAT THIS DOCUMENT IS BEING TRANSMITTED VIA FACSIMILE ON THE DATE INDICATED BELOW TO:</p> <p>Examiner: Tran, Phuc H. Art Unit: 2666 Fax: 571-273-8300</p> <p><u>Melissa F. Wellington</u> Name of Sender</p> <p><u>Melissa F. Wellington</u> Signature</p> <p><u>12-14-05</u> Date of Transmission</p>
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Respectfully submitted,

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